06-01-04

A f/3682

Attorney's Docket No.: 34580.001CC *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Paul Swift

Serial No.: 09/957,417

Filed: 10/10/2001

For the Invention of:

BICYCLE PEDAL THAT CAN FIT A MULTIPLICITY OF SHOE CLEATS

Group Art Unit No.: 3682

Examiner: Vinh Luong

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Commissioner for Patents

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APPELLANT 'S REPLY BRIEF (37 C.F.R. § 1.193(b)(1))

This brief is in response to the Examiner's Answer mailed from the Patent Office on April 2, 2004. This brief is transmitted in triplicate. The official mailing date of the Examiner's Answer was April 2, 2004. A Reply Brief must be filed within two months of that date which is June 2, 2004. This Reply Brief is being mailed by Express Mail to the Patent Office on May 28, 2004. Therefore, this Reply Brief is timely filed.

The fee required under 37 C.F.R. § 1.17(f) and any required petition for extension of time for filing the Appeal Brief were submitted with Appellant's Appeal Brief. It is believed that no additional fee is due for filing this Reply Brief to the Examiner's Answer. However, if the Commissioner should determine that any additional fee is required for filing this Reply Brief, then the Commissioner of Patents is hereby authorized to charge my Deposit Account No. 18-2222 for any such appropriate fee.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(a))

I hereby certify that this Appellant's Reply Brief is being deposited with the United States Postal Service on May 28, 2004 with sufficient postage as Express Mail No. EV 312732505 US in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: May 28, 2004

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ARGUMENTS

I. This is a very long extended prosecution history and the Patent Examiner Luong has issued a very long, extensive final rejection as well as made several points in his responsive Examiner's Answer.

The heart of the matter can be distilled down to basically two very fundamental arguments. First, is it fair to site the Gapinski Patent as a reference against this present application or is it unfair because the application should receive credit back to the filing date of the grandparent application which was filed on September 3, 1997 and was Application Serial No. 08/923,022 which predates the Gapinski Patent which would make the Gapinski Patent not a prior art reference to the present invention? The heart of the argument that is the central issue of this entire disagreement with Examiner Luong is whether or not the original patent application in Gapinski that was filed in 1997 can be construed to disclose the spring which forces the plate to spring back to lock the cleat in place. The Appellant has spent a very extensive amount of time arguing this point throughout the entire prosecution as well as in the Appeal Brief. Because of the extreme importance of this, the Appellant will focus on this argument once again so that it is clearly understood by the Patent Office Board of Appeals as to why the Appellant's arguments that the Appellant should receive a credit back to the grandparent case filed in 1997 which includes the disclosure of the bias spring which is a fundamental element of these claims should be considered and therefore, the Gapinski Patent is not a relevant prior art reference.

Specifically, as set forth in the Appellant's Brief on Page 18, beginning on Line 20, "Referring specifically to the original patent text on Page 9, the first full paragraph reads: 'Figure 5a shows a top view of the LOOK compatible flip-flop pedal. The top side consists of a toe clamp (202) which holds the front of the cyclist's LOOK compatible cleat (not shown). A spring plate (204) moves back when the cleat is inserted and snaps forward to lock the cleat on the pedal.' Therefore, it is abundantly clear that the spring action which is talked about is clearly intended and clearly discussed in the patent text. Obviously, it could not spring back in that way unless there was a spring tension that was causing it to spring back as discussed in the text. For

purposes of clarity, in Figure 18, the spring 580 has been shown but it is abundantly clear that it is about a bolt 205 which was fully disclosed in the original grandparent text."

It is abundantly clear that if the Patent Office Board of Appeals understands and accepts what the Appellant is saying, then the Gapinski Patent is not a reference because the critical element that makes the present invention patentable in the reworded claims is clearly disclosed, shown and talked about in the original grandparent case that dates back to 1997 which predates the Gapinski Patent which was only filed on March 18, 1998. Therefore, with the removal of the Gapinski reference which is the only reference cited against the Appellant, the patent claims as presently written will be allowed. Everything that the Patent Examiner has said with implication that Appellant and Applicant and former attorney of the Appellant conceded to what the Examiner said is simply wrong. The prosecution history clearly shows a clear trail going back to the very early original grandparent case filed in 1997 and nothing was said to concede to what the Patent Examiner implies in his Examiner's Answer. Clearly, in each case amendments were made to try and overcome the arguments. There was no implication as set forth by the Examiner in the Examiner's Answer that the Appellant conceded with what the Patent Examiner has said the various Office Actions.

Further, the Examiner's statement on the bottom of Page 3 of the Examiner's Answer which states "In fact, Figs. 5a-5c of SN'022 (this was the 1997 Patent) fail to show the biased spring that makes the plate 204 to be pivotable. More important, the plate 204 shown in Figs. 5a-5c of SN'022 appears to be fixedly or not pivotably attached to the pedal body 206." This is totally wrong based upon the quoted portion of the Appellant's Brief which is quoted directly from the original Patent Application 08/923,022 filed on September 3, 1997 which shows that it absolutely could not be fixed and certainly had to be spring biased.

Further, with respect to the Examiner's statement that "Appellant's failure to contest the rejection under 35 USC 112, first paragraph, in SN'561 is considered to be a *de facto* acquiescence to the validity of the Examiner's rejection under 35 USC 112, first paragraph, regarding the inadequate disclosure of the spring-loaded retaining plate/member in the parent application SN'561 and the grant parent application SN'022", nothing can be further from the

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truth. The Appellant sought the path of least resistance by amending the claims to bring them into condition for allowance and in no way conceded to the Examiner's rejection under 35 U.S.C. § 112 and certainly did not state that they agreed with the Examiner that the spring biased plate was not shown and not supported in the original grandparent case.

II. Further, the Gapinski Patent simply does not disclose the Appellant's invention. The Appellant will not repeat all of the extensive arguments that were made in Section II on Pages 21 through 25 of the Appeal Brief. However, the Appellant will address what the Examiner has said in his Examiner's Answer.

The Examiner is citing Figure 8 in Gapinski, column 5, line 55 to column 5, line 22. The spring action of Gapinski is a horizontal spring action because it involves a totally different product with a totally different mechanism as already discussed extensively in Section II of the Appellant's Appeal Brief. Figure 8 does not change this. It is still a horizontally moving spring. Further, the sections quoted by the Examiner once again refer to the horizontal movement, not to vertical movement. Therefore, the additional language as suggested by the Appellant clearly overcomes this and if the Patent Office Board of Appeals wishes to let the Appellant have this additional modified claim language as set forth in Appendix II of the Appeal Brief with only moderate language corrections, it is clear that the nature of the spring movement of the Appellant's device is totally different as it is rotating outwardly on a vertical plane rotation as opposed to the horizontal rotation in Gapinski.

CONCLUSION

Therefore, for all the reasons set forth very extensively in the Appellant's Appeal Brief and now in this Reply Brief, the Gapinski Patent never should be cited as a reference against the Appellant's application because the Appellant's application should have received credit for the earlier grandparent filing date of 1997 which would predate Gapinski and therefore, Gapinski is not a reference.

Even if it can be argued that Gapinski is a reference, for all the arguments set forth in Section II of the Appeal Brief, Gapinski is a totally different device operating in a totally

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different way on a totally different principle with a horizontal moving spring action as opposed to the vertical moving spring action of the Appellant's spring plate. Therefore, Gapinski is not a valid reference and in addition, Gapinski does not disclose or make obvious the Appellant's invention as currently claimed.

Therefore, the Patent Office Board of Appeals is respectfully requested to reverse the Patent Examiner and to allow the present application to issue and to order the Patent Examiner to issue a Notice of Allowance on the present application.

Respectfully submitted,

Date: May 28, 2004

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